

REMARKS

The Examiner has issued an Advisory Action retaining his prior rejections of the claims and indicating that the request for reconsideration although considered did not place the application in condition for allowance.

Based on the above amendment and the following remarks, the application is deemed to be in condition for allowance and action to that end is respectfully requested.

The Examiner has rejected claims 1,3, 4, 8 and 9, under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 4,470,873 to Nakamura (Nakamura) in view of Japanese Patent 11-273520 to Yoshikawa (Yoshikawa), U.S. Patent No. 4,831,484 to Bruch (Bruch), U.S. Patent No. 4,700,065 to Kordulla et. al. (Kordulla), U.S. Patent No. 4,620,094 to Tani et. al. (Tani), and U.S. Patent No. 4,103,155 to Clark (Clark). The Examiner has rejected claims 5 and 7, under 35 U.S.C. §103(a), as being unpatentable over Nakamura in view of Yoshikawa, Bruch, Kordulla, Tani and Clark, as applied to claim 1, and further in view of U.S. Patent No. 4,369,578 to Ernst (Ernst). Amended claim 1 and the claims that depend therefrom now recite that "parts of the conductor strips, leading from the electronic module to the probe, being disposed outside the housing" and that "at least one fuse is provided in the conductor strips, leading from the electronic module to the probe, within the housing."

It is respectfully submitted that all of the claims presently pending in the application are patentably distinct over the prior art, including all of the prior art of record in the application, and are, therefore, allowable. The combination of the cited prior art does not lead to the claimed invention nor does such a combination provide the advantages of the invention.

Nakamura shows a probe of a scanning device for a position measuring system. Nakumara fails to disclose housing parts with part of the probe outside the housing, a fuse of lower melting point that interrupts current at a specific temperature, a sectional constriction, and parts of the conductor strips, leading from the electronic module to the probe, being disposed outside the housing.

Yoshikawa fails to disclose parts of the conductor strips, leading from the electronic module to the probe, being disposed outside the housing.

The fuse, in Bruch, is not placed between the electronic module and the probe. A fault in the electronic module could still lead to an excessive current in the probe.

Cordulla shows an optical encoder with LEDs in housing 14 and a photodiode (the probe) 40 in housing 16. The probe in Cordulla is completely inside the housing.

Tani shows an optical encoder like the encoder shown in Cordulla. The probe of Tani is not placed completely outside the housing and this avoids all the problems with electrical connections in hazardous surroundings.

Clark shows an encoder with a conventional housing 28. All parts of the probe are inside the housing. The encoder is connected to other equipment by cable 26. The cable 26 is exposed outside the housing, as any cable connected to a housing is exposed to the outside of such a housing, but it does not comprise conductor strips. Clark does not teach conductor strips, leading from the electronic module to the probe, being disposed outside the housing

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so." *In re*

Fritch, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992) (footnote omitted) (emphasis in original). See also In re Sernaker, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983); SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1468, 1475 (Fed. Cir. 1988); In re Laskowski, 10 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

The Court of Appeals for the Federal Circuit clearly stated:

It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

The In re Fritch holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicant’s own statements”. The prior art must be viewed “without reading into that art Appellant’s teachings” and the teachings of the prior art should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obvious.” In re Spinnoble, 160 U.S.P.Q. 237, 243 (CPA 1969).

There is no suggestion, incentive or motivation in the cited reference for the combination on which the Office Action relies. A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness. MPEP § 2143.01 relying on Ex Parte Levengood, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter. 1993). The Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record is any *evidence*, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would have been motivated to

make the modification of the prior art "necessary to arrive at the claimed invention." *In re Jones* 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992).

Ex Parte Clapp, 227 USPQ 972,973 (Bd. Pat. App & Inter. 1985) requires that when the references do not suggest the invention "... the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the references." No such line of reasoning is seen in the Office Action.

There is no suggestion in the cited prior art that would lead one of ordinary skill in the art to attempt a combination of these references to achieve the invention as claimed in claim 1. Claims 5 and 7-9 depend on claim 1 and are allowable for the same reasons claim 1 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with the features recited in claim 1, are not disclosed or suggested in the prior art.

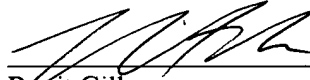
CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed to issue.

Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully Submitted,



Renit Gillon
Reg. No. 39,202

Dated: August 25, 2003
Sidley Austin Brown & Wood LLP
787 Seventh Avenue
New York, N.Y. 10019
Tel.: (212) 839-7354

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail and addressed to: Commissioner for Patents, Alexandria, VA 22313-1450 on August 25, 2003.

